

REMARKS

This paper is submitted in response to the Office Action of December 14, 2004. Prior to entry of this response, claims 27-54 were pending in the application, of which claims 27 and 43 are independent. In the Office Action, claims 27-54 were rejected under 35 U.S.C. § 112, claims 43, 44, 49, and 50 were rejected under 35 U.S.C. § 102(b), and claims 27-29, 32, 35-42, 45-47, and 51-54 were rejected under 35 U.S.C. § 103(a). Claims 30, 31, 33, 34, and 48 were rejected under the nonstatutory doctrine of double patenting. Following this response, claims 27-54 remain pending in this application. Applicants have amended claim 43 to improve its clarity without narrowing its scope. Applicants hereby address the Examiner's rejections in turn.

I. Rejection of the Claims Under 35 U.S.C. § 112, First Paragraph

In the Office Action, the Examiner rejected claims 27-54 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement, stating that the specification, as originally filed, does not provide support for the claimed subject matter of a sheath or an outer sheath comprising a halogen-free fire resistant mixture as recited in claims 27 and 43. Because claims 28-42 and 44-54 depend from claim 27 and claim 43, respectively, each of those claims was included in the rejection as well.

In response to this rejection, Applicants respectfully point the Examiner to page 15, lines 21-22 of the specification, which states: "The sheath 6 can be a halogene free fire resistant mixture according to DIN VDE 0266." Reference to Figure 8a of the specification, as originally filed, supports the subject matter of claims 27 and 43 and requests that this rejection of claims 27-54 be withdrawn.

II. Rejection of the Claims Under 35 U.S.C. § 102(b)

The Examiner rejected claims 43, 44, 49, and 50 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,576,940 to Stone *et al.* ("Stone"). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP 2131; *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Because Stone does not expressly or inherently teach every element of claims 43, 44, 49, and 50, Applicants respectfully submit that the 102(b) rejection is improper.

Amended claim 43, from which claims 44, 49 and 50 depend, recites a method for making an electrical cable, comprising forming on a conductor a first insulation layer and a second insulation layer, and forming a sheath comprising a halogen-free fire resistant mixture. In the Office Action, the Examiner points to element 15 of Stone as disclosing a halogen-free fire resistant sheath. Applicants, however, do not find any teaching or disclosure in Stone that element 15 is halogen-free or any mention of the idea of a halogen-free sheath. Nor does Stone appear to mention that a halogen-free outer sheath prevents hydrochloric acid from forming during exposure of the cable to high temperatures, as Applicants have found. To the contrary, Stone teaches one embodiment in which the cable comprises an outer layer containing "chlorinated parafins (*sic*) and halogenated phenols." (Stone, col. 5, ll. 31-60). Accordingly, independent claim 43 patentably distinguishes the present invention over the cited art, and Applicants respectfully request withdrawal of the rejection of claim 43, as well as its dependent claims 44, 49 and 50.

III. Rejection of Claims Under 35 U.S.C. § 103(a)

In the Office Action, the Examiner rejected various claims as being unpatentable under 35 U.S.C. § 103(a) over Stone. In particular, the Examiner rejected dependent claims 51 and 52 as being obvious over Stone, rejected independent claim 27 and dependent claims 29, 32, 35, 40-42, 46, and 47 over Stone in view of Applicant Admitted Prior Art - Figure 3 of Applicant's specification ("AAPA FIGURE 3"), rejected dependent claims 28 and 36 over Stone in view of AAPA FIGURE 3 and further in view of DE 4437596 (DE '596), rejected claims 37-39 over Stone in view of AAPA FIGURE 3 and further in view of AAPA FIGURE 5, rejected claim 45 over Stone in view of DE '596, and rejected claims 53 and 54 over Stone in view of AAPA FIGURE 5.¹ Applicants respectfully traverse these rejections.

Claims 51, 52, 46, 47, 45, 53, and 54 each depend from, and therefore include all the limitations of claim 43, which requires forming a sheath comprising a halogen-free fire resistant mixture. Consequently, claims 51, 52, 46, 47, 45, 53, and 54 are patentable at least due to their dependence from independent claim 43, for the reasons explained above.

Moreover, as also discussed above, Stone does not teach the formation of a sheath comprising a halogen-free fire resistant mixture, nor does it suggest modifying its teachings to form a halogen-free sheath. In fact, Stone actually teaches away from providing a halogen-free outer layer. In citing Stone against Applicants, the Examiner

¹ Although the heading in the Office Action for the rejection of claims 53 and 54 identifies only AAPA FIGURE 5, the text of the rejection indicates that the Examiner has applied Stone and AAPA FIGURE 5.

must consider the entire disclosure: "A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." MPEP 2141.02; *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). At column 5, lines 31-34, Stone teaches an embodiment in which the cable comprises an outer sheath containing "chlorinated parafins (*sic*) and halogenated phenols." Therefore, because Stone teaches away from a halogen-free sheath, the Examiner has not established a *prima facie* case of obviousness, and Applicants respectfully request that these rejections be withdrawn.

The Examiner also rejected independent claim 27 and its dependent claims 28, 29, 32, and 35-42. Independent claim 27, as with independent claim 43, requires a sheath comprising a halogen-free fire resistant mixture. As discussed above, nothing in Stone teaches or suggests a halogen-free sheath, and in fact Stone teaches away from such a sheath. Nothing in the AAPA FIGURE 3 suggests modifying Stone to include this limitation of the claimed invention, nor does the Examiner claim that it does. Because the cited combination does not include all the limitations of claims 27, the Examiner has not established a *prima facie* case of obviousness, and Applicants respectfully request that the rejection of claim 27 be withdrawn.

Similarly, claims 28, 29, 32, and 35-42 are patentable due at least to their dependence from independent claim 27, for the reasons set forth above. Moreover, the combinations of Stone and the cited secondary references do not teach or suggest a sheath comprising a halogen-free fire-resistant mixture, and the Examiner points to nothing in them that teaches a halogen-free fire resistant sheath. Therefore, the cited combinations do not teach or suggest each recitation of the rejected claims 28, 29, 32,

and 35-42, and the Examiner has not established a *prima facie* case of obviousness.

Accordingly, Applicants respectfully request that this rejection be withdrawn.

IV. Double Patenting

The Examiner rejected claims 30, 31, 33, 34, and 48 under the judicially-created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 13-16 of U.S. Patent No. 6,781,062 to Kuss *et al.* ("Kuss") in view of Stone. In relying on the combination of Kuss and Stone, the Examiner asserts that Stone discloses a cable comprising an outer sheath (15) comprising a halogen-free fire resistant mixture. As discussed above in regard to the Examiner's 35 U.S.C. 103(a) rejections, Applicants do not see where Stone teaches or implies that outer sheath (15) is halogen-free. Nor does Stone suggest that it would be beneficial to provide a halogen-free sheath. In fact, at col. 5, ll. 31-60, Stone discloses a cable that includes a sheath comprising chlorinated paraffins and halogenated phenols, thus teaching away from providing a halogen-free sheath. Accordingly, the cited combination of Kuss and Stone does not teach or suggest each limitation of claims 30, 31, 33, 34, and 48, and the Examiner's assertion that the cited combination renders those claims obvious is incorrect. Applicants therefore request that the double patenting rejection be withdrawn.

V. Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims. The preceding arguments are based only on the arguments in

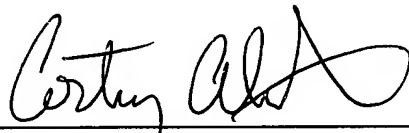
the Office Action, and therefore do not address patentable aspects of the invention that were not addressed by the Examiner in the Office Action. The claims may include other elements that are not shown, taught, or suggested by the cited art. Accordingly, the preceding argument in favor of patentability is advanced without prejudice to other bases of patentability.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: May 13, 2005

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